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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,022	07/31/2001	Anthony J. Baerlocher	0112300-820	3718

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EXAMINER	
HARRISON, JESSICA	

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/919,022	BAERLOCHER ET AL.	
	Examiner	Art Unit	
	Jessica J. Harrison	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 May 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-49* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-49* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5/5/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Applicant's amendment/remarks/affidavit/disclaimer of May 5, 2004 have been received. Claims 1-49 are pending. Claims 1, 9, 23 and 47 have been amended.

Terminal Disclaimer

The terminal disclaimer filed on May 5, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent 6,602,136 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 112

The claim rejections previously set forth under 35 USC 112 second paragraph to claims 1, 23 and 47 have been overcome by applicant's amendment. In particular, applicant has now recited the processor to be "operable to" perform various recited functions. It can only be inferred from this action that applicant intends the recited functions to be limiting of the processor and the processor therefore to include the appropriate means (software, as disclosed) for performing these functions. The prior rejections set forth against claims 26, 37 and 41 (and dependents) is not agreed with by the instant examiner and therefore withdrawn from the record.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9, 13, 14, 23, 24, 26, 27, 31, 34 and 37-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Jaffe 6,517,432.

The rejection contained in the prior office action is maintained and incorporated herein. The amendatory language to claims 1, 9, 23 and 47 provide clarity and do not substantively alter the claim scope in that the prior rejection was based upon an assumption that the functions were found limiting to the processor structure. The rejection is repeated herein for convenience.

Claims 1, 23, 24, 26, 37, 38, 41, 42, 44 and 46: Jaffe teaches a path including a plurality of locations (Figs. 5, 7, 9, 11, 12), a bonus value associated with at least one of the locations (5:21-24), at least one player symbol and at least one terminating symbol (5:12 – 15), and a display device which displays the path and the symbols to the player (2:36-42). The processor, electronically connected to the display device includes means for causing the player symbol to visit at least one of the locations on the path

(5:12-15); and causing the terminating symbol to visit at least one of the locations on the path (5:12-15); and providing the player with any bonus values associated with the location(s) visited by the player symbol (5:21-36).

Claims 2, 27, 40, 45, 47-48: Jaffe teaches the path used by the player and terminator symbol is random (5:12-15; 43-47);. The play field is also shown in a matrix array (fig. 6 – 13)) which would allow a cyclical path, depending on the random outcome generated by the processor.

Claims 3, 4, 14, 31, and 39: Jaffe teaches a game termination when both player and terminating symbol occupy the same place on a path (6:4-12).

Claims 5, 6, 49: Jaffe teaches the game termination as discussed in claims 3-4, which states that when player symbols occupy the same space at the same time, the game ends. A pass would have both symbols occupy the same space at the same time, this ending the game.

Claim 7: Jaffe teaches sequential location visitation until a predetermined count (6:4-12).

Claim 8, 9, 13, 34, and 43: Jaffe teaches a move indicator displayed on the display device by moving the player and terminator symbol from one location to another location as discussed above. The moves only come in response to player-initiated input (3:4-9).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 10-12, 15-22, 28-30, 32, 33, 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaffe in view of DeMar 6,520,855.

The rejection contained in the prior office action is maintained.

Claims 10-12, 28-30: Jaffe teaches the claimed limitations as discussed above, but does not teach lap indicators. DeMar teaches a bonus game with features taken from a game entitled MONOPOLY (5:1-5) having features such as a cyclical path and a player character. The bonus game also includes a lap indicator as well as bonuses for completed laps (Fig 16b and 37:6-23). One would be motivated to modify Jaffe to include the additional bonus features as Jaffe teaches that developing and adding new features to bonus games satisfies the demands of both players and operators (1:45-53). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Jaffe and add the additional bonus feature taught by DeMar (lap indicators) to enhance existing bonus game by adding new features and thus satisfying the demands of players and operators.

Claims 15 and 32: DeMar teaches a path including a predetermined number of laps along a path (37:24-28).

Claim 16: DeMar teaches a lap bonus value as discussed above.

Claim 17: DeMar teaches a lap bonus for each lap completed by a player as discussed above.

Claim 18: Jaffe teaches a move indicator as discussed in claims 8, 9 and 13.

Claims 19-20: DeMar teaches a lap and bonus indicator as discussed above.

Claim 21: DeMar teaches a player symbol with a starting path (22:16-19 and 11:31-38).

Claims 22 and 36: Jaffe in view of DeMar teaches the limitation as discussed above, but fails to teach a sound associated with a visit to a location. However, DeMar teaches that an animation is associated with at least one location in a game (41:65-67). As is known in the art, animation and sounds are equivalents in terms of player sensory stimulators, and as such it would have been considered within the capabilities of one of ordinary skill at the time of the invention to either replace or include sound associated with a visit to a location in Jaffe in order to further enhance the existing bonus game additional features. Furthermore, placement of sound and animation does not serve to modify any structural changes in the game play/outcome other than aesthetic value, thus any improvements thereof would have been considered within the capabilities of one or ordinary skill at the time of the invention.

Claims 33 and 35: DeMar teaches awarding a bonus value for completed laps as discussed above. Any bonus earned for a complete lap also means that a player has not yet been caught.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jaffe in view of DeMar as applied to claim 1-24 and 26-49 above, and further in view of Vancura 6,033,307.

Claim 25: Jaffe in vie w of DeMar teaches the limitations discussed above but does not teach an outcome as a deduction from a bonus award provided to a player. Vancura teaches a gambling game with a bonus game (Abstract) where an outcome can be a deduction from a bonus award (Fig. 5). One would be motivated to modify the combination as set forth above to include additional bonus features as Jaffe teaches that developing and adding new features to bonus games satisfies the demands of both players and operators (1:45-53). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Jaffe in view of DeMar and add the additional bonus feature taught by Vancura to enhance existing bonus game by adding new features and thus satisfying the demands of players and operators.

Response to Amendment

The affidavit filed on May 5, 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Jaffe reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Jaffe reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is

more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). No **factual** evidence has been submitted to address this requirement. An internal request for game development is not factual evidence of the conception of the claimed invention. Further, this internal request is not related to the instant claims: no description of conception of the claimed features such as, for example: symbols passing each other on the path; sequentially visiting path locations; lap indicators. This listing is not meant to be exhaustive.

Further, the evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Jaffe reference. Again, no **factual** evidence has been submitted to address this requirement. Applicant has asserted that a game was approved by the Nevada Gaming Control board, but provides no factual evidence as to what that game comprises nor relates any aspect of what was approved to any claimed limitation. There is no link between the submissions and the claimed invention.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Jaffe reference to either a constructive reduction to practice or an actual reduction to practice. No evidence has been submitted to address this requirement. Applicant has failed to address the activities relating to due diligence between the alleged date of

conception (December 1998) and the alleged date of reduction to practice (January 2000) in any meaningful manner. It is unknown if, or how, applicant took steps to develop and/or protect his invention during this gap of 13 months.

Given at least the above reasons, applicant submission under 37 CFR 1.131 is ineffective to overcome the Jaffe reference.

Response to Arguments

Other than submitting Jaffe is not prior art to the instant invention, and submitting the DeMar alone does not teach that which is claimed, applicant provides no other arguments regarding the rejections. As outlined above, Jaffe indeed remains applicable as prior art to the invention.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In

no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica J. Harrison whose telephone number is 703-308-2217. The examiner can normally be reached on M-F during business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jessica J. Harrison
Primary Examiner
Art Unit 3714

jjh